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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,031	10/24/2005	Josef Laumen	112740-1059	9038
29177	7590	07/17/2006	EXAMINER	
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			BROOKS, SHANNON	
			ART UNIT	PAPER NUMBER
			2631	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

10/529,031

**Applicant(s)**

LAUMEN ET AL.

**Examiner**

Shannon R. Brooks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/25/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/24/05</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on March 24, 2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 14, 15, 17-19, 21, 22, and 24-26** are rejected under 35 U.S.C. 102(b) as being anticipated by Capitani et al. (US 006976011B1).

Consider **Claim 14**, Capitani et al. clearly teach and disclose a method for providing paying services within a radio communication network operating in accordance with one of a GSM Standard and a UMTS Standard, the method comprising: providing at least one radio communication terminal including a device for user identification, the device being one of a SIM and a USIM (**Col.6, lines 51-53**); providing at least one device for providing the paying

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services (**read as payment server**)(Col.2, line 49); making a request for one of the paying services by the radio communication terminal (Col.1, lines 44-50); and transmitting, in response to the request, at least one message (**read as data related to payment**)(Col.4, lines 58-63) generated by the user identification device to the device for providing the paying services .

Consider **Claim 15**, Capitant et al. clearly teach and disclose a method for providing paying services as claimed in claim 14, wherein the device for providing the paying services, upon receipt of at least one message, effects a method comprising: initiating a check of an account status assigned to the user identification device (Col.3, lines 11-13); enabling provision of the requested paying service if a result of the check is positive (read as subscriber is authenticated)(lines 26-29); and blocking provision of the requested paying service if the result of the check is negative (read as subscriber is not authenticated).

Consider **Claim 17**, Capitant et al. clearly teach and disclose a method for providing paying services as claimed in claim 14, wherein the at least one message contains a first item of information (**read as subscriber identification**)(Col.2, lines 43-47) identifying the radio communication terminal.

Consider **Claim 18**, Capitant et al. clearly teach and disclose a method for providing paying services as claimed in claim 17, wherein the at least one message contains a second item of information (**read as buyer's authentication**)(Col.3, lines 44-57) identifying a current service request.

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Consider **Claim 19**, Capitant et al. clearly teach and disclose a method for providing paying services as claimed in claim 14, wherein the at least one message describes an order of the services (**read as prices**) requested by the radio communication terminal (**Col.9, lines 3-6**).

Consider **Claim 21**, Capitant et al. clearly teach and disclose a user identification device in a radio communication terminal for use in a method for providing paying services within a radio communication network operating in accordance with one of a GSM Standard and a UMTS Standard, comprising parts for generating, upon a request being made for one of the paying services (**data about the prices**) (**Col.9, line 5**) by the radio communication terminal, a request message addressed to a device for providing the paying services, the request message thereafter being transmitted to the device (**the sales server**) (**Col.9, line 4**) for providing the paying services.

Consider **Claim 22**, Capitant et al. clearly teach and disclose a user identification device as claimed in claim 21, wherein the user identification device is one of an SIM and a USIM (**Col.4, line 8**).

Consider **Claim 24**, Capitant et al. clearly teach and disclose a device for providing paying services within a radio communication network operating in accordance with one of a GSM Standard and a UMTS Standard, comprising: parts for evaluating at least one message generated by a user identification device of a radio communication terminal during a request for one of the paying services made by the radio communication terminal (**read as management and/or payment center**)(**Col.4, line 61**); parts for initiating the requested paying service (**read as**

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**SIM)(Fig.2); and parts for providing the requested paying service (read as Supplier's sales server and Payment server)(Fig. 5).**

Consider **Claim 25**, Capitant et al. clearly teach and disclose a device for providing paying services as claimed in claim 24, wherein the device is embodied as a distributed arrangement including a network control device (**read as management center**)(**Fig.5**) of the radio communication system for controlling a server, with the network control device including both the parts for evaluating (**Fig.5, Block 50**) and the parts for initiating (**Fig.5, Block 52**) the requested paying services.

Consider **Claim 26**, Capitant et al. clearly teach and disclose a device for providing paying services as claimed in claim 24, wherein the device is embodied as a server (**read as Payment server**) (**Fig.5**).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 16 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Laumen et al. (US 2006/0135117 A1) in view of Pailles (US 20040083166).

Consider **Claim 16**, Laumen et al. teach a method for providing paying services, except that it does not disclose wherein at least one message is formulated as a command of a command set implemented in the user identification device as specified in one of an SIM Application Toolkit, a USIM Application Toolkit and a Card Application Toolkit.

Pailles teaches wherein at least one message is formulated as a command of a command set implemented in the user identification device as specified in one of an SIM Application Toolkit, a USIM Application Toolkit and a Card Application Toolkit(US 2004/0083166)(Pg.3, [0058]).

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Therefore it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Pailles into Laumen to use one of an SIM Application Toolkit, a USIM Application Toolkit and a Card Application Toolkit to activate a particular menu on a display.

Consider **Claim 23**, Laumen et. Al teach a user identification device, except that it does not teach wherein a command set implemented in the user identification device as specified in one of an SIM Application Toolkit, a USIM Application Toolkit and a Card Application Toolkit generates the request message.

Pailles teaches wherein a command set implemented in the user identification device as specified in one of an SIM Application Toolkit, a USIM Application Toolkit and a Card Application Toolkit generates the request message (US 2004/0083166)(Pg.3, [0058]).

Therefore it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Pailles into Laumen to use one of an SIM Application Toolkit, a USIM Application Toolkit and a Card Application Toolkit to enable action on a display.

**Claim 20** is rejected under 35 U.S.C. 103(a) as being unpatentable over Laumen et al. (US 2006/0135117 A1) in view of Sivula (US 006907239 B1).

Consider **Claim 20**, Laumen et al. teach a method for providing paying services, except that it does not teach wherein the paying services are at least one of a transfer of mobile emails, instant messaging, video telephony, a multimedia messaging service and a short message service, and



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the at least one message contains, depending upon a type of requested service, additional data required for providing the service.

Sivula et al. teach wherein the paying services are at least one of a transfer of mobile emails, instant messaging, video telephony, a multimedia messaging service and a short message service, and the at least one message contains, depending upon a type of requested service, additional data required for providing the service (US 006907239B1) (Col.6, lines 58-67).

Therefore it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Sivula into Laumen to use paying services wherein the paying services are at least one of a transfer of mobile emails, instant messaging, video telephony, a multimedia messaging service and a short message service to provide a list of services that the service provider offers, and the at least one message (read as conveying a list of services)(Col.6, line 61) contains, depending upon a type of requested service, additional data required for providing the service.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Brune et al. (US 6993320) disclose a Method and Device for Accessing A Telecommunications Network and for Billing Telecommunications Services.

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents

P.O. Box 1450

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**Hand-delivered responses** should be brought to

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shannon Brooks whose telephone number is (571) 270-1115.

The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez-Gutierrez can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDAN ORGAD  
PATENT EXAMINER/TELECOMM.

*Edan Orgad* 7/16/06